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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,153	07/21/2003	Jens C. Thies	021028-0305107	5213
43569	7590	06/19/2006	EXAMINER	
MAYER, BROWN, ROWE & MAW LLP 1909 K STREET, N.W. WASHINGTON, DC 20006			HAMILTON, CYNTHIA	
			ART UNIT	PAPER NUMBER
			1752	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/623,153	<b>Applicant(s)</b> THIES ET AL.	
	<b>Examiner</b> Cynthia Hamilton	<b>Art Unit</b> 1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 April 2006.
- 2a) ☒ This action is FINAL.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14, 16-18, 20-24 and 27 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-14, 17-18, 20-24, 27 is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

1. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamura et al (WO 00/63272 A1). The compositions set forth in claim 3 of Yamamura et al wherein the choice of glycidyl group compound is made as always a glycidyl ether compound and is a selection such as that set forth in the table on page 44 make obvious the instant compositions in view of the components of claim 3 of Yamamura because of the overlap of percentages for the specific compounds and the disclosure of a composition with ranges within except for instant component A the claimed invention. The closeness of 30% to 29% in Example 8 of Yamamura et al makes obvious such a close variance of from 30% to 29%. Claim 16 is compared to claim 3 of Yamamura in the table below:

Instant claim 16	Yamamura et al claim 3	Instant claim 16 Overlap if Yamamura wants 100 parts total as found in table on page 44
1-29wt% oxetane compound	(A) 5-80 parts by wt oxetane compound	1-29 wt%
10-85wt% glycidyl ether	(B) 5-80 parts by wt of glycidyl group epoxy compound (one choice of two)	10-80 wt% and all examples of glycidyl given in Table on page 44 are glycidyl ether compounds
1-25wt% multifunctional acrylate compound	0-45 parts by wt of ethylenically unsaturated monomer	1-25wt% of ethylenically unsaturated compound used with only example on page 44 being multifunctional acrylate compound
Radical photoinitiator present	0-10 parts by wt of radical	When present

	photopolymerization initiator	
Cationic photoinitiator present	0.1 to 10 parts by weight of photoacid generator	Total overlap

In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Werthheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 UAPQ2d 1934 (Fed. Cir. 1990). See particularly MPEP 2144.05. The instant invention of claim 16 in no manner limits the amount of ester groups in cationic compounds present, thus there is no limit to the presence of such as found in Yamamura et al. Applicants have presented no arguments with respect to claim 16. This rejection stands with the added clarification made of record to allow applicants to determine more readily what action to take if they decide not to cancel claim 16.

2. Claims 1-14, 17, 18, 20-24 and 27 are allowed. Applicants’ amendment to claim 1 removes the issue of Yamamura et al and example 8. Applicant’s amendment to claim 14 clarifying the issue of “ster” makes clear that 30 parts of 3,4-epoxycyclohexylmethyl-3',4'-epoxycyclohexanecarboxylate as used by Yamamura in their Example 8 is much higher than the limit of 25.33 wt% the same when considering the as 100 meq of ester linkages /100 grams of the instant composition is much lower. With respect to claims 17-18, the examiner notes that she did not fully appreciate that A was 0-25 wt % and not 0-29% as found in claim 1 before amendment.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 1752

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.*

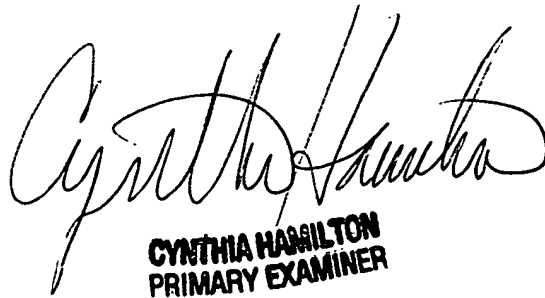
*Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Hamilton whose telephone number is 571-272-1331. The examiner can normally be reached on Monday through Friday 9:30 am to 5:00 pm.*

*If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571) 272-0729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.*

Art Unit: 1752

*Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.*

June 9, 2006

A handwritten signature in black ink, appearing to read 'Cynthia Hamilton', is written over a rectangular stamp.

Cynthia Hamilton  
Primary Examiner  
Art Unit 1752

**CYNTHIA HAMILTON  
PRIMARY EXAMINER**